

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

70

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/190,536 11/12/98 DWYER

J B653-024

NATHANIEL LEVIN
WHITMAN BREED ABBOTT & MORGAN LLP
200 PARK AVENUE
NEW YORK NY 10166

WM01/1025

EXAMINER

GAUTHIER, G

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED:

10/25/01

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

22

Office Action Summary

Application No.

09/190,536

Applicant(s)

DWYER ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. **Claim 21** is objected to because of the following informalities: "ones" on line 16 should be "one". Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claim 1**, "said other data processing device" on line 15 lacks of antecedent basis because it is unclear which "other data processing device" it refers to the claim.

Regarding **claim 11**, "said other information processing device" on line 10 lacks of antecedent basis because it is unclear which "other information processing device" it refers to the claim.

Regarding **claim 18**, "the other information processing device" on line 1 lacks of antecedent basis because it is unclear which "other information processing device" it refers to the claim.

Claim 19, line 1 and **claim 20** line1 have the same problem.

Claims 2-10, 12-17 are depended on rejected claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-8, 10-18, 20, 29-34 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al U. S. Patent No. 5986568 (hereinafter Suzuki).

Regarding **claims 1**, Suzuki discloses a voice data management system, comprising:

a portable digital audio recorder, which includes memory means for storing a plurality of voice data files, said memory means storing corresponding header data in association with each of the stored data files (see 2 on FIG. 1);

a personal computer (see 3 on FIG. 1);

means for transferring one of said voice data files and the corresponding header data from the portable recorder to the personal computer (see 4 on FIG. 1);

an information processing device other than said portable recorder and said personal computer (see 30 on FIG. 27); and

means, interconnecting said personal computer with said other information processing device, for permitting transmission of data from said personal computer to said other data processing device (see 3 on FIG. 27);

wherein said personal computer reads said header data transferred to the personal computer, and on the basis of said header data, determines whether to transfer the corresponding voice data file to said other information processing device (see "DESTINATION ID" on FIG. 8).

Regarding **claims 2, 12 and 30**, Suzuki discloses a voice data management system, wherein said header data read by said personal computer includes data which identifies an author of the voice data file corresponding to said header data (see "NAME OF INPUT PERSON" on FIG. 8).

Regarding **claims 3, 13 and 31**, Suzuki discloses a voice data management system, wherein said header data read by said personal computer includes data which identifies said portable digital audio recorder (see "CORRESPONDING ITEM ADDRESS" on FIG.8).

Regarding **claims 4, 14 and 32**, Suzuki discloses a voice data management system, wherein said header data read by said personal computer includes data which identifies an intended recipient for the voice data file corresponding to said header data (see "DATA PORTION" on FIG. 8).

Regarding **claims 5, 15 and 33**, Suzuki discloses a voice data management system, wherein said header data read by said personal computer includes data which identifies a subject matter of the voice data file corresponding to said header data (see "CLASSIFICATION OF DATA" on FIG. 8).

Regarding **claims 6 and 16**, Suzuki discloses a voice data management system, wherein said header data read by said personal computer includes data, which identifies a work location (see "CORRESPONDING ITEM ADDRESS" on FIG. 8).

Regarding **claims 7 and 17**, Suzuki discloses a voice data management system, wherein said header data read by said personal computer includes a work type field (see "PATIENT ID" on FIG. 8).

Regarding **claims 8, 18 and 34**, Suzuki discloses a voice data management system, wherein said other information processing device is another personal computer (see 16 on FIG. 3).

Regarding **claims 10, 20 and 36**, Suzuki discloses a voice data management system, wherein said other information processing devices is a voice mail system (see 30 on FIG. 27).

Regarding **claim 11**, Suzuki discloses a method of operating a voice data management system, comprising the steps of:

generating a voice data file in a portable digital audio recorder, said file including voice data and header data (see FIG. 6A, 6B, 6C and 6D):

transferring said voice data file from said recorder to a personal computer (see FIG. 8);

reading the header data in said transferred voice data file (see "HEADER PORTION" on FIG. 8);

on the basis of the header data that has been read, determining whether to transfer said voice data from said personal computer to said other information processing device (see "DESTINATION ID" on FIG. 8).

Regarding **claim 29**, Suzuki discloses a method of operating a voice data management system, comprising the steps of:

generating a voice data file in a portable digital audio recorder, said file including voice data and header data (see FIG. 6A-6D);

transferring said voice data file from said recorder to a personal computer (see FIG. 8 and column 10, lines 2-6):

reading the header data in said transferred voice data file (see column 11, lines 48-56);

on the basis of the header data that has been read, selecting an information processing device separate from said personal computer (see "DESTINATION ID" on FIG. 8); and

transferring said voice data from said personal computer to said selected information processing device (see column 10, lines 7-9).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-26, 28, 37-39 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Kahn et al U. S. Patent No. 6122614 (hereinafter Kahn).

Regarding **claim 21**, Suzuki discloses a voice data management system, comprising:

a portable digital audio recorder which includes memory means for storing a plurality of voice data files, said memory means storing corresponding header data in association with each of the stored voice data files (see 2 on FIG. 1);

a personal computer (see 3 on FIG. 1);

means for transferring said voice data files and the corresponding header data from the portable recorder to the personal computer (see 4 on FIG. 1).

Suzuki differs from **claim 21** of the present invention in that Suzuki did not disclose a plurality of information processing devices.

However, Kahn teaches a plurality of information processing devices other than said portable recorder and said personal computer (see 15, 50 and 51 on FIG. 1); and

means, interconnecting said personal computer with said plurality of information processing devices, for permitting transmission of data from said personal computer to selected one of said plurality of data processing devices (see 30 on FIG. 1);

wherein said personal computer reads said header data transferred to the personal computer, and on the basis of said header data, selects one of said plurality of information processing devices to receive a voice data file corresponding to said header data and transmits the corresponding voice data file to the selected data processing device (see FIG. 2d).

Since using a plurality of information processing devices would help to have more users receiving voice data; therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have the system of Suzuki as modified by Kahn adding the plurality of information processing devices as taught by Kahn.

The modification will help more user on the system such that service provider of Suzuki may have the possibility to process voice data files.

Regarding **claim 22**, Suzuki and Kahn disclose everything as applied to **claim 21** above, in addition Suzuki teaches a method wherein said header data read by said personal computer includes data which identifies an author of the voice data file corresponding to said header data (see "NAME OF INPUT PERSON" on FIG. 8).

Regarding **claim 23**, Suzuki and Kahn disclose everything as applied to **claim 21** above, in addition Suzuki teaches a method wherein said header data read by said personal computer includes data which identifies said portable digital audio recorder (see "CORRESPONDING ITEM ADDRESS" on FIG.8).

Regarding **claim 24**, Suzuki and Kahn disclose everything as applied to **claim 21** above, in addition Suzuki teaches a method wherein said header data read by said personal computer includes data which identifies an intended recipient for the voice data file corresponding to said header data (see "DATA PORTION" on FIG. 8).

Regarding **claim 25**, Suzuki and Kahn disclose everything as applied to **claim 21** above, in addition Suzuki teaches a method wherein said header data read by said personal computer includes data which identifies a subject matter of the voice data file corresponding to said header data (see "CLASSIFICATION OF DATA" on FIG. 8).

Regarding **claim 26**, Suzuki and Kahn disclose everything as applied to **claim 21** above.

Suzuki fails to disclose the plurality of information process devices.

However, Kahn discloses a voice data management system, wherein said one of said plurality of information processing devices selected by said personal computer is another personal computer (see 40 on FIG.1).

Since using a plurality of information processing devices would help to have more users receiving voice data; therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have the system of Suzuki as modified by Kahn adding the plurality of information processing devices as taught by Kahn.

The modification will help more user on the system such that service provider of Suzuki may have the possibility of choosing other personal computer.

Regarding **claim 28**, Suzuki and Kahn disclose everything as applied to **claim 21** above, in addition Suzuki teaches a method wherein said one of said plurality of information processing devices selected by said personal computer is a voice mail system (see 30 on FIG. 27).

Regarding **claim 37**, Suzuki discloses a method of operating a voice data management system, comprising the steps of:

dictating voice information into a portable audio recorder (see 2 on FIG. 1);

storing the voice information in the portable audio recorder in the form of digital voice data (see column 50-54);

dictating recipient information into the portable audio recorder (see "DESTINATION ID" on FIG. 8);

transferring said digital voice data from said recorder to a personal computer (see column 4, lines 53-54);

Suzuki differs from **claim 37** of the present invention in that Suzuki did not disclose speech recognition and a plurality of information processing devices.

However, Kahn discloses a method of applying a speech recognition algorithm to said recipient information to generate recipient data (see column 6, lines 23-25);

selecting a data processing device from among a plurality of data processing devices connected to said personal computer, on the basis of said recipient data (see 30 on FIG. 1); and

transferring said digital voice data from said personal computer to said selected data processing device (see FIG. 2d).

Since using speech recognition algorithm and a plurality of information processing devices would help to have more users receiving voice recording data; therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have the system of Suzuki as modified by Kahn adding the speech recognition algorithm and a plurality of information processing devices as taught by Kahn.

The modification will help more user on the system such that service provider of Suzuki may have the possibility to process voice with speech recognition algorithm.

Regarding **claim 38**, Suzuki and Kahn disclose everything as applied to **claim 37** above a method, comprising the step of transferring said dictated recipient information from the recorder to said personal computer in the form of digital voice data (see column 4, lines 53-54).

Suzuki differs from **claim 38** of the present invention in that Suzuki did not disclose speech recognition algorithm.

However, Kahn discloses a method wherein said speech recognition algorithm is applied to said transferred recipient information by said personal computer to generate said recipient data (see column 6, lines 23-33).

Since using speech recognition algorithm would help to have more users receiving voice recording data; therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have the system of Suzuki as modified by Kahn adding the speech recognition algorithm as taught by Kahn.

The modification will help more user on the system such that service provider of Suzuki may have the possibility to process voice data files with speech recognition algorithm.

Regarding **claim 39**, Suzuki and Kahn disclose everything as applied to **claim 37** above a method, comprising the step of transferring said recipient data from said recorder to said personal computer (see column 4, lines 53-54).

Suzuki differs from **claim 39** of the present invention in that Suzuki did not disclose speech recognition algorithm.

However, Kahn discloses a method, wherein said speech recognition algorithm is applied to said dictated recipient information by said portable audio recorder to generate said recipient data (see column 6, lines 43-47).

Since using speech recognition algorithm would help to have more users receiving voice recording data; therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have the system of Suzuki as modified by Kahn adding the speech recognition algorithm as taught by Kahn.

The modification will help more user on the system such that service provider of Suzuki may have the possibility to process voice data files with speech recognition algorithm.

Regarding **claim 40**, Suzuki discloses a voice data management system, comprising:

a portable digital audio recorder which includes a microphone for inputting voice information, memory means for storing said voice information in the form of digital voice data, and means for designating a portion of said digital voice data as recipient information (see 2 on FIG. 1);

a personal computer (see 3 on FIG. 1);

means for transferring digital voice data from said recorder to said personal computer (see column 4, lines 53-54).

Suzuki differs from **claim 40** of the present invention in that Suzuki did not disclose a plurality of data processing devices and speech recognition algorithm.

However, Kahn discloses a plurality of data processing devices (see 15, 50 and 51 on FIG. 1);

means interconnecting said personal computer to said data processing devices for transmission of data from said personal computer to said data processing devices (see 30 on FIG. 1); and

means for generating recipient data by applying a speech recognition algorithm to digital voice data designated as recipient information by said means for designating (see column 6, lines 43-47);

said personal computer selecting one of said data processing devices separate from said portable recorder and said personal computer on the basis of said recipient data generated by said means for generating (see FIG. 2d), and said personal computer transferring to said selected data processing device digital voice data transferred from said recorder to said personal computer (see column 7, lines 4-21).

Since using speech recognition algorithm and all the limitations disclosed by Kahn would help to have more users receiving voice recording data; therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have the system of Suzuki as modified by Kahn adding the speech recognition algorithm and the limitations as taught by Kahn.

The modification will help more users on the system such that service provider of Suzuki may have the possibility to record and process voice data files with speech recognition algorithm.

Regarding **claim 41**, Suzuki and Kahn disclose everything as applied to **claim 40** above.

Suzuki differs from claim 40 fails to disclose a means for generating recipient data is included in said personal computer.

However, Kahn discloses a voice data management system, wherein said means for generating recipient data is included in said personal computer (see column 7, lines 21-24).

Since generating recipient data included in said personal computer would help to have more users receiving voice recording data; therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have the system of Suzuki as modified by Kahn adding the means for generating recipient data in the personal computer by Kahn.

The modification will help more users on the system such that service provider of Suzuki may have the possibility to record and process voice data files in a personal computer.

Regarding **claim 42**, Suzuki and Kahn disclose everything as applied to **claim 40** above, in addition Suzuki teaches a method wherein said means for generating recipient data is included in said portable digital audio recorder (see FIG. 16).

Regarding **claim 43**, Suzuki and Kahn disclose everything as applied to **claim 40** above.

Suzuki differs from **claim 43** fails to disclose a means for transmission of data from said personal computer to said data processing devices includes a local area network.

However, Kahn discloses wherein said means for transmission of data from said personal computer to said data processing devices includes a local area network (see 30 on FIG.1).

Since generating recipient data included in said personal computer would help to have more users in the network receiving voice recording data; therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have the system of Suzuki as modified by Kahn adding the means for transmission of data from personal computer to other data processing devices includes a local area network as taught by Kahn.

The modification will help more users accessing the system such that service provider of Suzuki may have the possibility to record and process voice data files in a local network area.

5. **Claims 9, 19, 27 and 35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki and Kahn as applied to **claims 1, 11, 21 and 29** above, and further in view of Breslawsky U. S. Patent No. 5898916.

Regarding **claims 9, 19, 27 and 35**, Suzuki and Kahn disclose everything as applied to **claims 1, 11, 21 and 29** above.

Suzuki and Kahn differ from **claims 9, 19, 27 and 35** fail to disclose the other information processing device as a central dictation system.

However, Breslawsky discloses an other information processing device, a central dictation system (see 14 on FIG.1).

Since a central dictation system would help to have more users recording voice data; therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have the system of Suzuki as modified by Kahn and further modified by Breslawsky adding the central dictation system.

The modification will help more users accessing the system such that service provider of Suzuki and Kahn may have the possibility to record and process voice data files in a voice data management system.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sander et al. is cited for an apparatus for displaying the status of individual dictated messages in a central dictation system (see FIG. 1).

Webb is cited for a portable hands-free digital voice recording and transcription device (see FIG. 2 and 3).

Brady is cited for a voice recording method and system providing context specific storage and retrieval (see FIG. 1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Application/Control Number: 09/190,536
Art Unit: 2645

Page 20

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



G.G.

October 15, 2001

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

